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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/714,987	09/17/1996	HUGH SHARKEY	17616-705	4099
26166 7590 10/20/2008 FISH & RICHARDSON P.C. SMITH & NEPHEW, INC. 150 Minuteman Road Andover, MA 01810				
EXAMINER				
SHAY, DAVID M				
ART UNIT		PAPER NUMBER		
3769				
MAIL DATE		DELIVERY MODE		
10/20/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

08/714,987

Applicant(s)

SHARKEY ET AL.

Examiner

david shay

Art Unit

3735

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on April 9, 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 90-108, 110, 112 and 114-118 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 90-108, 110, 112 and 114-118 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Applicant argues that the amendments to the claims render them allowable as the additional steps are taught away from by Kirwin. The examiner must respectfully disagree. It is well known in the art, and specifically taught by Roth et al, that treating the prostate to reduce its bulk does not occur only at a single point, but at a series of linearly placed contiguous treatment points, even when circumferentially separated treatment zones are used. Thus applicant's arguments are not convincing.

Claims 90-93, 95-100, and 116-118 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirwin in combination with Swanson et al ('184) and Roth et al. Kirwin teaches a method of tissue shrinkage, but does not teach measuring temperature. Swanson et al ('184) provide the teaching the desirability of determining the temperature of tissue to which energy is applied. Roth et al teach that when debulking the prostate, as a treatment for BPH, linearly contiguous treatment zones are produced by treating points in an overlapping fashion, even when using circumferentially separated treatment zones. It would have been obvious to the artisan of ordinary skill to provide the temperature detector configurations and methods of Swanson et al in the method of Kirwin, since this would allow the temperature to be maintained in the desired range more easily, which control will necessarily affect the depth to which the shrinkage effect occurs, or to employ the shrinkage method of Kirwin in the method of Swanson et al, since this would destroy the electrical functionality of the tissue, without removing it, or compromising its stability-inducing structural integrity, and in either case, to move the device from a first selected site to a second selected site adjacent or overlapping the first selected site, so as to form a linear lesion, as taught by Roth et al, since this is well within the scope of one having ordinary skill in the art; is not critical; provides no unexpected result; and since the

production of linear lesions substantially longer than the lesion producing surface of the surgical probe is well recognized in the field of both cardiac and prostatic lesion formation, thus producing a method such as claimed.

Claims 101-108, 110, 112, 114, and 115 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirwin in combination with Swanson et al ('184) and Roth et al, as applied to claims 90-93 and 95-100 above, and further in view of Sand ('709). Sand ('709) teaches a method of tissue shrinkage, noting that collagen is the compound responsible for the shrinkage, and also noting that collagen is contained in ligaments and tendons, and also that the shrinkage can be used to treat musculoskeletal injuries, Sand also notes that the controlling parameter for the shrinkage is temperature. It would have been obvious to the artisan of ordinary skill to employ the tendon and ligament shrinkage method of Sand in the combined methods of Roth et al, Swanson et al, and Kirwin, since this would allow the treatment of musculoskeletal injuries, such as injuries to the knee and ankle, which would otherwise require grafts to achieve similar results, or to employ the RF based shrinkage method of Kirwin in the method of Sand, since Sand explicitly teaches that the controlling parameter for shrinkage is the temperature of the tissue, rather than any particular energy used to produce the temperature change, and to employ the temperature sensor of Swanson et al, for the same reason, and to employ the linear application of Roth et al, since tendons and ligaments are elongated tissues, which extend primarily linearly, official notice of which is hereby taken, thus producing a method such as claimed.

Applicant's arguments with respect to claims 90-93, 95-108, 110, 112, and 114-118 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to david shay whose telephone number is (571) 272-4773. The examiner can normally be reached on Tuesday through Friday from 6:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Johnson, can be reached on Monday through Friday from 7:00 a.m. to 3:30 p.m. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

Art Unit: 3735

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private

PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/david shay/

Primary Examiner, Art Unit 3735